

REMARKS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

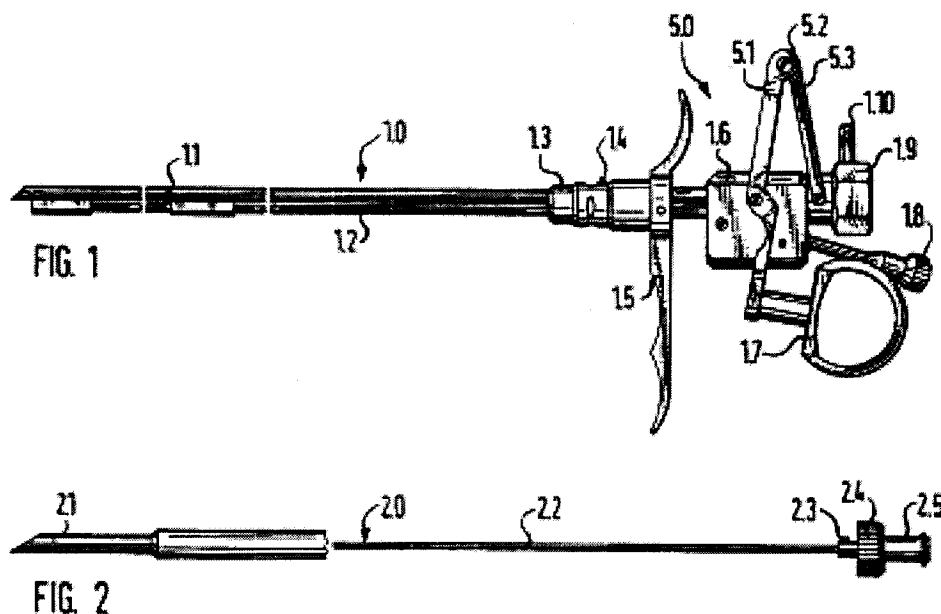
Claims 1, and 3-7 remain in the application. Claim 1 has also been amended to more specifically describe the invention, stating that optics traverse the claimed main body and the inner shaft. This particularly distinguishes the invention from the cited reference to Bonnet (U.S. Patent 5,685,853, hereinafter Bonnet). The Bonnet device, as described in more detail below, does not have an inner shaft (for feeding fluid) that is within an outer shaft (for removing fluid) and through which optics pass. Additional amendment of claim 1 has been made to help distinguish the invention over other prior art.

Claims 1-7 stand rejected under 35 U.S.C. §102(b) as being anticipated by Bonnet. For the following reasons, the Examiner's rejection is traversed.

Bonnet is directed to an injection device (Figs. 1 and 2 reproduced below) for injecting substances into human tissue. Bonnet provides an optics tube 1.1 and a cannula guide tube 1.2 located next to the optics tube. An injection cannula 2.0 (see Fig. 2 of Bonnet) is inserted into a coupling 1.8 and then into the cannula guide tube 1.2 and secured therein using a union nut 2.4.

Regarding claim 1, in general, the difference between the claimed invention and the device in Bonnet is that the claimed invention is a modern resectoscope and Bonnet is an injection device that can have an old-style endoscope shaft mounted

thereon (see Fig. 5 of Bonnet). In a modern resectoscope, irrigation fluid is supplied through an inner shaft and removed through the outer shaft (the space defined between the inner shaft and an outer shaft). The inner shaft also houses the optics used in a modern resectoscope. This configuration is not present in Bonnet. Fluid can only be introduced and removed in an embodiment of Fig. 5 of Bonnet, through a common shaft 4 (the only true shaft of the Bonnet device). No fluid can be supplied through either the optics tube 1.1 or cannula guide tube 1.2 in Bonnet.



The preferred embodiment of Bonnet includes a main body (the structure including elements 1.3, 1.4 and 1.5 which can be gripped via the handgrip 1.5) wherein the operators thumb fits into ring 1.7 to allow movement of the device.

Specifically, to accentuate the claimed differences between the claimed device and Bonnet, Applicant has first amended claim 1 to include optics that traverse both the claimed main body and the inner shaft. The Examiner, in Bonnet,

defines element 2.0 as an inner tube, but it is clear that no optics traverse this element and, thus, is clearly different from the claimed invention. Instead, the optics are within the optics guide tube 1.1, which the Examiner considers to be the outer shaft.

Further, Applicant has clarified claim 1 to clearly state that the outer shaft is connectable (detachable) to the main body by an outer connector element. The Examiner states that union nut 2.4 in Bonnet is a connector element for an outer shaft. This is not true. The Examiner has defined element 2.0 as the inner shaft and it is clear from Fig. 2 of Bonnet that union nut 2.4 is a connector for element 2.0, not element 1.2 that the Examiner has called an outer shaft. In fact, shaft 1.2 in Bonnet is not shown as being detachable in any manner.

Finally, union nut 2.4 is not connected to the main body (structure 15, to which the guide for slide carriage 16 is attached) as required, but instead is connected only to inner shaft 2.0 in Bonnet.

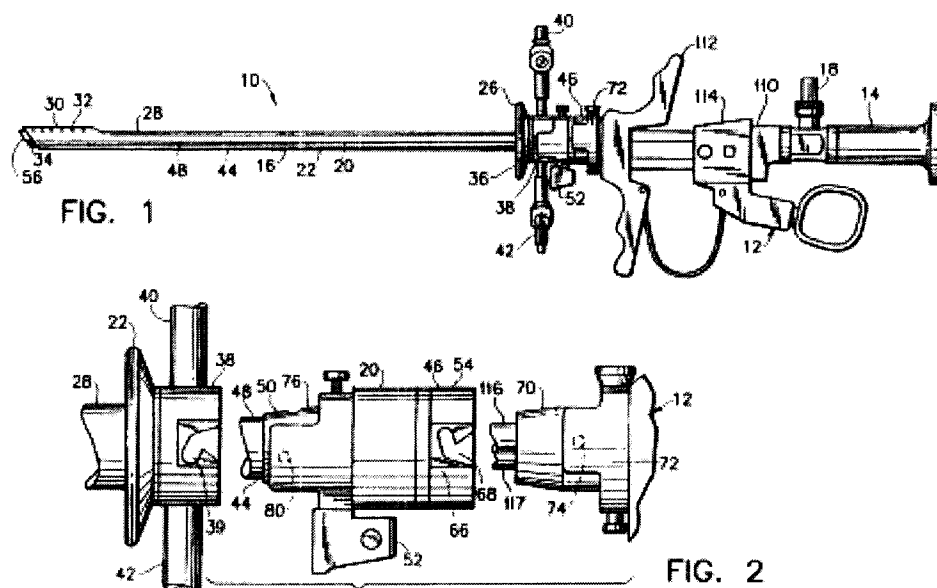
Claims 3-6 depend directly or indirectly from claim 1 and are believed to be allowable at least for the reasons stated above.

Regarding claim 7, Bonnet does not show an inner shaft that comprises a connector element engaging the outer connector element between the outer shaft and the main body, as required. Rather, in Bonnet the union nut 2.4 engages the coupling 1.8 at the end of guide tube 1.2 and the endoscope shaft 1.0 is on the opposite side of the connection point. This configuration is the opposite of the spatial relationship defined by Applicant's claim language.

For at least the reasons stated above, reconsideration and withdrawal of the rejection of claims 1-7 as being anticipated by Bonnet is respectfully requested.

Claims 1-6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 5,486,155 to Muller (hereinafter Muller). For the following reasons, the Examiner's rejection is traversed.

Muller represents relevant art, but discloses an apparatus over which the present invention is an improvement. Referring to Figs. 1 and 2 of Muller (shown below) two accessible connection points are illustrated and associated latches that facilitate connection between two parts of the endoscope. Specifically, the outer shaft 28 and its associated connector 38 connect to the inner shaft structure 20 which has a pin 80 that fits into a notch 39 on the outer shaft connector. Similarly a pin 74 on the main body 112 fits into a notch 68 on the inner shaft structure 20. Muller describes, in its Background section by reference to U.S. 4,920,961, how these latches are released by pressing on the control buttons (shown below) situated on the top of the inner shaft structure and main body respectively. As can be seen in Fig. 1 of Muller, the control buttons are always accessible to the user.



Having two connection points with latch buttons that are always accessible results in extending the length of the insertable portion of the endoscope *and*

associated optics (which is not desirable). Instead it is desirable to extend the insertable portion *without* extending the optics. The present invention does this by improving upon the design of Muller by having only a *single* connection point that is always accessible, thus maximizing the insertable length without extension of the length of the optics.

Applicant has amended claim 1 to better accentuate the differences in the present invention and prior art of the type disclosed within Muller (Figs. 1 and 2 shown below). In addition to noting that optics traverse the main body and inner shaft of the resectoscope, claim 1 clearly states that the outer shaft is directly connectable to *the main body* by a connector element. To clearly define the main body, claim 1 states that the slide carriage guide is affixed to, and proximally extends from the main body. Also the inner and outer shafts extend distally from the main body.

Applicant questions the Examiner's rejection of claim 1, specifically regarding the ability of the outer shaft to be directly connected to the main body by the connector element. The Examiner refers to elements 26 and 28 of Muller as the main body of the resectoscope. The Examiner then refers to element 22 as the outer shaft and states that the outer shaft is detachable. Applicant believes these statements by the Examiner are contradictory. The outer shaft 22 as defined in Muller has a tube 28 and rear end section 26 (see Col. 2 Lines 33-37 of Muller). However the outer shaft, element 22 cannot be detached from itself, namely elements 26 and 28, and thus, as presented by the Examiner, the disclosure of Muller does not anticipate claim 1.

In Muller, the structure including the handle 112 should be considered the

main body. Similar to the claimed invention, a slide carriage guide extends from the proximal end of this main body. Also, the inner shaft extends distally from the main body. But in contrast to the claimed invention, the outer shaft is not connectable to the main body and does not extend therefrom. Rather, in Muller, the outer shaft is attached to the inner shaft structure and is detachable therefrom.

Applicant believes that claim 1, as currently amended, clearly distinguishes over Muller, no matter how Muller is interpreted. Referring to Fig. 2 in Muller, if the structure including element 38 of Muller is considered to be the claimed connecting element (as stated by the Examiner), then only the structure including element 20 could be considered to be the main body (connector element must be directly connected to the main body), but element 20 is not proximally affixed to a slide carriage guide, as required by claim 1 (it is only affixed to cone connector 70 and latch 72).

In summary, the present invention is an improvement over Muller because the insertable portion of the endoscope is lengthened without extending the optics.

Claim 3-6 depend directly or indirectly from amended claim 1 and are believed to be allowable at least for the reasons stated above.

Reconsideration and withdrawal of the rejection of claims 1-6 as being anticipated by Muller is respectfully requested.

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Muller in view of U.S. Patent 2,532,043 to Wallace (hereinafter Wallace). For the following reason, the Examiner's rejection is questioned. The Examiner states that element 14 within Wallace represents the claimed connector element within claim 7. However, in Muller label number 14 represents a portion of a tapered passageway,

that is not an element at all, but instead an open space. Applicant requests clarification of the Examiner's rejection or alternatively, a withdrawal of the rejection of claim 7 under §103(a).

If clarification of the amendment or application is desired, or if issues are present which the Examiner believes may be quickly resolved, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. SCH-15904.

Respectfully submitted,

RANKIN, HILL, PORTER & CLARK LLP

By /James A. Balazs/
James A. Balazs, Reg. No. 47401

4080 Erie Street
Willoughby, Ohio 44094-7836
(216) 566-9700